

# Patent Public Advisory Committee Quarterly Meeting

## Patent Trial and Appeal Board Update



James Donald Smith  
Chief Administrative Patent Judge  
Patent Trial and Appeal Board  
August 14, 2014



# Topics

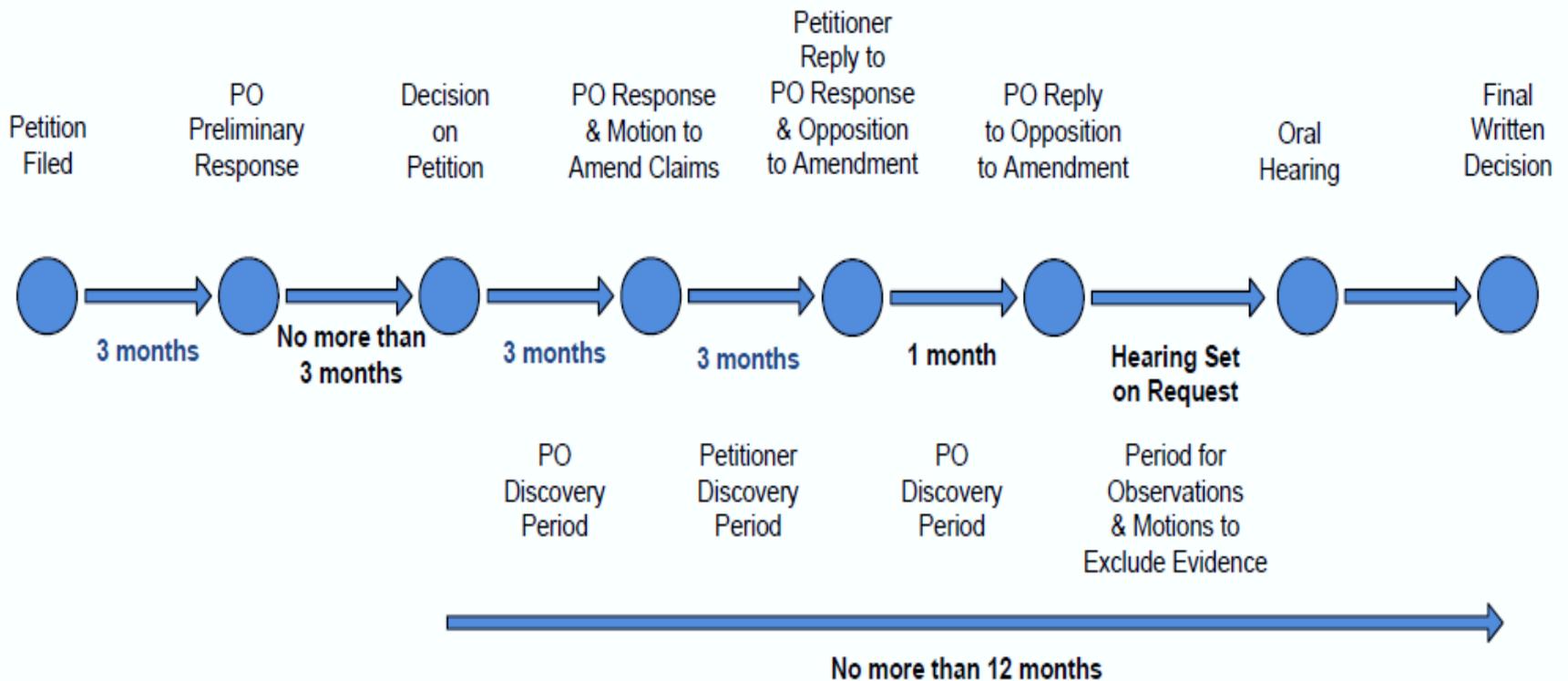
- AIA Trials Overview
- Appeals Overview
- Administrative Patent Judge Recruitment
- Administrative Patent Judge Training
- PTAB Website



# AIA Trials Overview



# Trial Timeline





# AIA Petitions

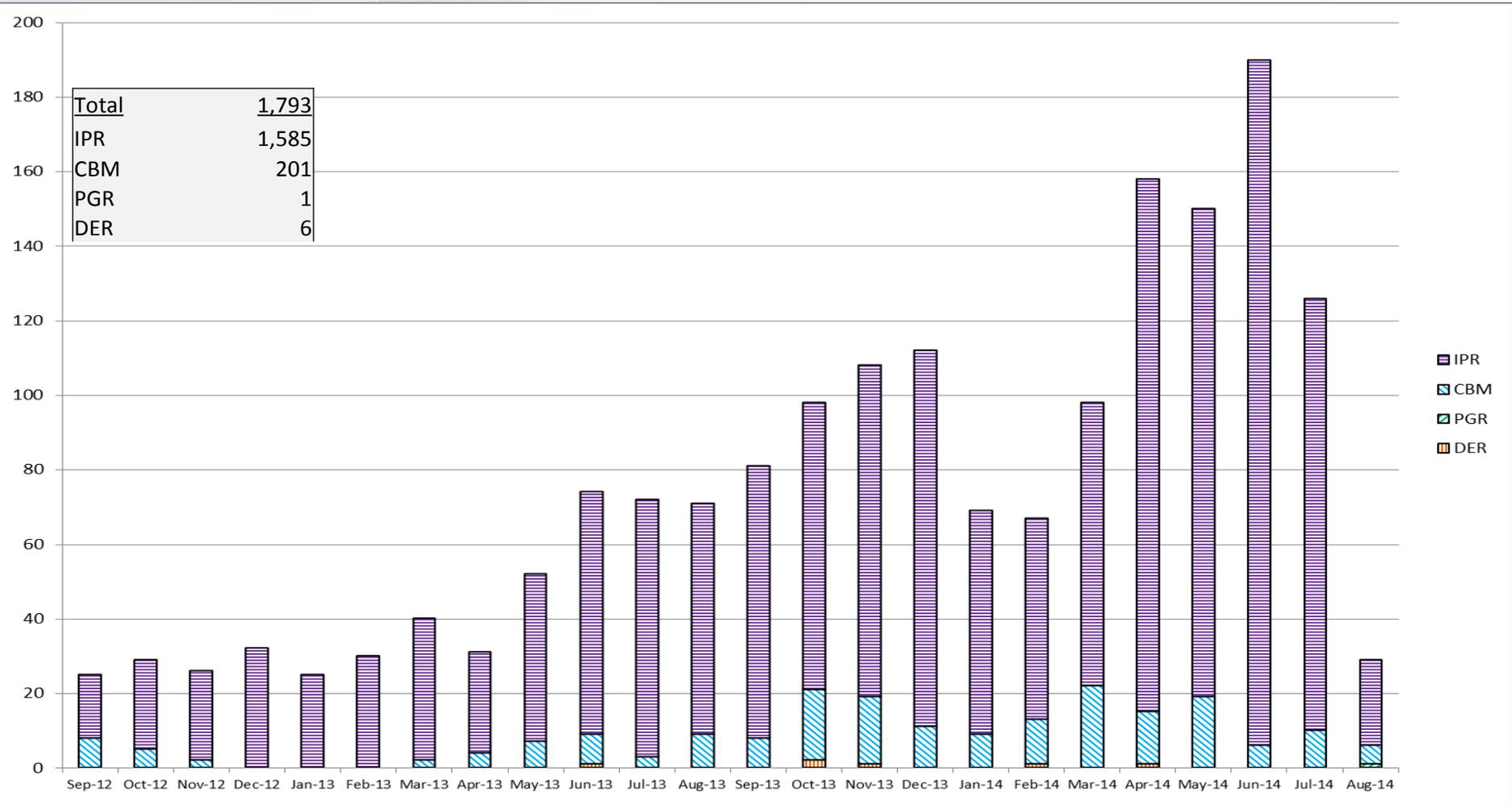
(Cumulative Numbers as of August 7, 2014)





# AIA Progress (as of August 7, 2014)

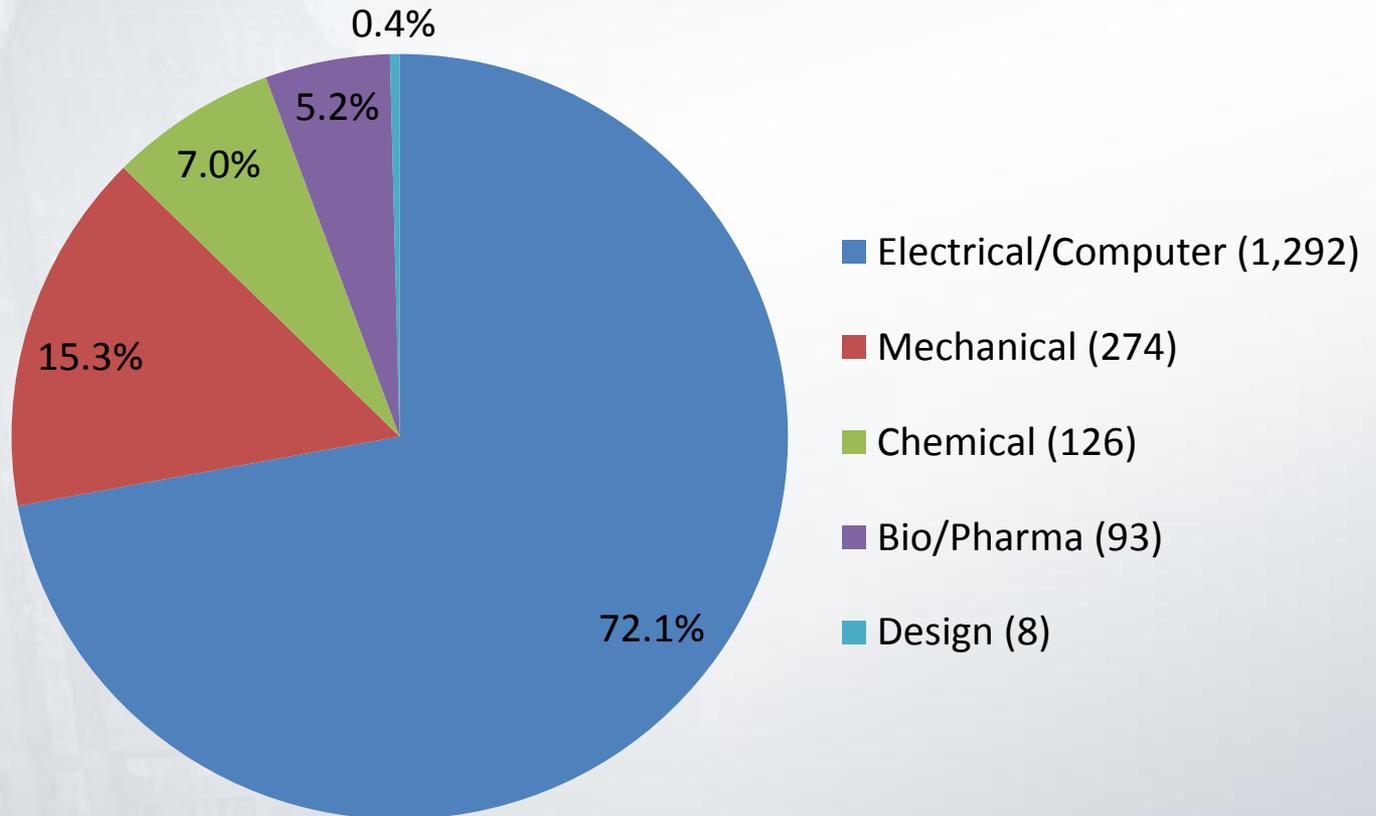
- AIA Monthly Filings





# AIA Progress (as of August 7, 2014)

- AIA Petition Technology Breakdown





# AIA Progress (as of August 7, 2014)

- Cumulative Patent Owner Preliminary Responses

	<b>Filed</b>	<b>Waived</b>
<b>IPR</b>	878	245
<b>CBM</b>	132	18



# AIA Progress (as of August 7, 2014)

- AIA Petition Dispositions

		<b>Trials Instituted</b>	<b>Joinders</b>	<b>Percent Instituted</b>	<b>Denials</b>	<b>Total No. of Decisions on Institution</b>
<b>IPR</b>	FY13	167	10+	87%	26	203
	FY14	449	13+	76%	149	611
<b>CBM</b>	FY13	14		82%	3	17
	FY14	62	1+	72%	25	88
<b>DER</b>	FY14	-		0%	3	3



# AIA Progress (as of August 7, 2014)

- AIA Final Dispositions

		<b>Settlements</b>	<b>Adverse Judgments</b>	<b>Final Written Decisions</b>
<b>IPR</b>	FY13	38	2	0
	FY14	142	33	104
<b>CBM</b>	FY13	3	0	1
	FY14	19	0	10



# Recent Precedential and Informative Opinions

- **Precedential Opinion**
  - *Securebuy, LLC v. CardinalCommerce Corporation* (CBM 2014-00035)
- **Informative Opinions**
  - *International Flavors and Fragrances Incorporated v. The United States of America* (IPR 2013-00124)
  - *Idle Free Systems, Incorporated v. Bergstrom, Incorporated* (IPR 2012-00027)
  - *Garmin International, Incorporated v. Cuozzo Speed Technologies LLC* (IPR 2012-00001)



# AIA Trial Feedback

- Nationwide listening tour conducted in April and May 2014
- Federal Register Request for Comments published in June 2014
  - <http://www.gpo.gov/fdsys/pkg/FR-2014-06-27/pdf/2014-15171.pdf>
  - Written comments must be received on or before September 16, 2014.



# Non-rule Specific Comments

- Requiring the parties to engage in settlement discussions
- Service of Notice of Appeal from PTAB final trial decision
- Fairness of trial continuance if parties settle
- Scope of estoppel
- PTAB issuance of precedential and informative decisions
- Availability of oral argument audio files and transcripts
- Notice of PTAB trial decisions
- Availability of trial statistics



# Questions for Comment

- 17 questions posed for public input on many topics including:
  - Claim construction: Under what circumstances, if any, should the Board decline to construe a claim in an unexpired patent in accordance with its broadest reasonable construction in light of the specification of the patent in which it appears?
  - Amendment practice: What modifications, if any, should be made to the Board's practice regarding motions to amend?
  - Patent owner preliminary response: Should new testimonial evidence be permitted in a Patent Owner Preliminary Response?
  - Obviousness
  - Real party in interest
  - Discovery
  - Multiple proceedings
  - Oral hearing
  - Extension of 1 year statutory period
- Submit comments to [TrialsRFC2014@uspto.gov](mailto:TrialsRFC2014@uspto.gov) by September 16, 2014



# 17 Issues Most Frequently Raised

## **Claim Construction Standard**

1. Under what circumstances, if any, should the Board decline to construe a claim in an unexpired patent in accordance with its broadest reasonable construction in light of the specification of the patent in which it appears?



# 17 Issues Most Frequently Raised

## **Motion To Amend**

2. What modifications, if any, should be made to the Board's practice regarding motions to amend?

## **Patent Owner Preliminary Response**

3. Should new testimonial evidence be permitted in a Patent Owner Preliminary Response? If new testimonial evidence is permitted, how can the Board meet the statutory deadline to determine whether to institute a proceeding while ensuring fair treatment of all parties?



# 17 Issues Most Frequently Raised

## **Obviousness**

4. Under what circumstances should the Board permit discovery of evidence of non-obviousness held by the petitioner, for example, evidence of commercial success for a product of the petitioner? What limits should be placed on such discovery to ensure that the trial is completed by the statutory deadline?



# 17 Issues Most Frequently Raised

## **Real Party in Interest**

5. Should a patent owner be able to raise a challenge regarding a real party in interest at any time during a trial?

## **Additional Discovery**

6. Are the factors enumerated in the Board's decision in *Garmin v. Cuozzo*, IPR2012–00001, appropriate to consider in deciding whether to grant a request for additional discovery? What additional factors, if any, should be considered?



# 17 Issues Most Frequently Raised

## Multiple Proceedings

7. How should multiple proceedings before the USPTO involving the same patent be coordinated? Multiple proceedings before the USPTO include, for example: (i) Two or more separate AIA trials; (ii) an AIA trial and a reexamination proceeding; or (iii) an AIA trial and a reissue proceeding.

8. What factors should be considered in deciding whether to stay, transfer, consolidate, or terminate an additional proceeding involving the same patent after a petition for AIA trial has been filed?



# 17 Issues Most Frequently Raised

## **Multiple Proceedings**

9. Under what circumstances, if any, should a copending reexamination proceeding or reissue proceeding be stayed in favor of an AIA trial? If a stay is entered, under what circumstances should the stay be lifted?

10. Under what circumstances, if any, should an AIA trial be stayed in favor of a copending reexamination proceeding or reissue proceeding? If a stay is entered, under what circumstances should the stay be lifted?



# 17 Issues Most Frequently Raised

## **Multiple Proceedings**

11. Under what circumstances, if any, should a copending reexamination proceeding or reissue proceeding be consolidated with an AIA trial?

12. How should consolidated proceedings be handled before the USPTO? Consolidated proceedings include, for example: (i) Consolidated AIA trials; (ii) an AIA trial consolidated with a reexamination proceeding; or (iii) an AIA trial consolidated with a reissue proceeding.



# 17 Issues Most Frequently Raised

## **Multiple Proceedings**

13. Under what circumstances, if any, should a petition for an AIA trial be rejected because the same or substantially the same prior art or arguments previously were presented to the USPTO in a different petition for an AIA trial, in a reexamination proceeding or in a reissue proceeding?



# 17 Issues Most Frequently Raised

## **Extension of 1 Year Period To Issue Final Determination**

14. What circumstances should constitute a finding of good cause to extend the 1-year period for the Board to issue a final determination in an AIA trial?



# 17 Issues Most Frequently Raised

## Oral Hearing

15. Under what circumstances, if any, should live testimony be permitted at the oral hearing?

16. What changes, if any, should be made to the format of the oral hearing?



# 17 Issues Most Frequently Raised

## General

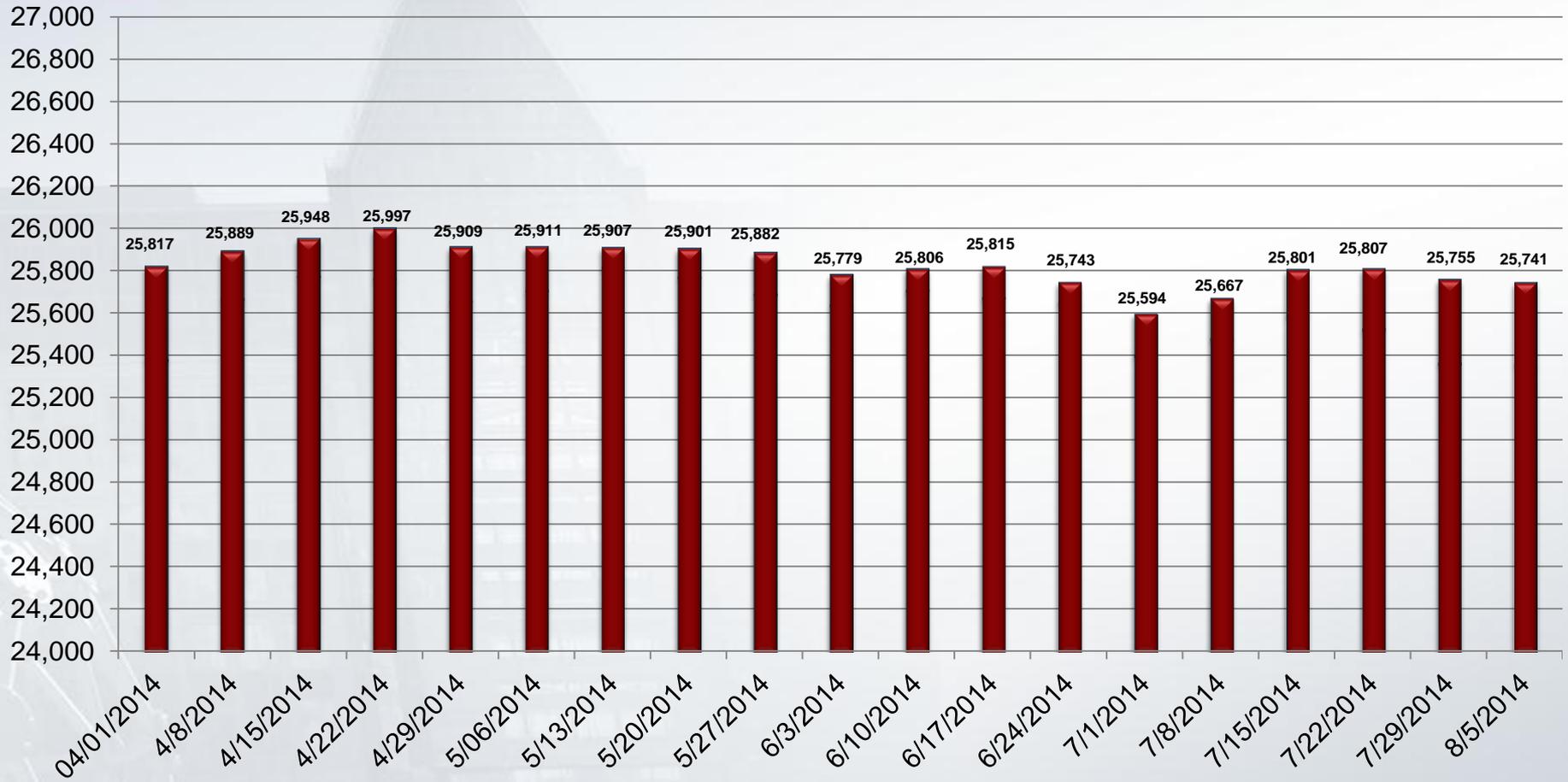
17. What other changes can and should be made in AIA trial proceedings? For example, should changes be made to the Board's approach to instituting petitions, page limits, or request for rehearing practice?



# Appeals Overview



# PTAB Inventory – Pending Ex Parte Appeals (excluding appeals from reexamination proceedings)





# PTAB Receipts and Dispositions

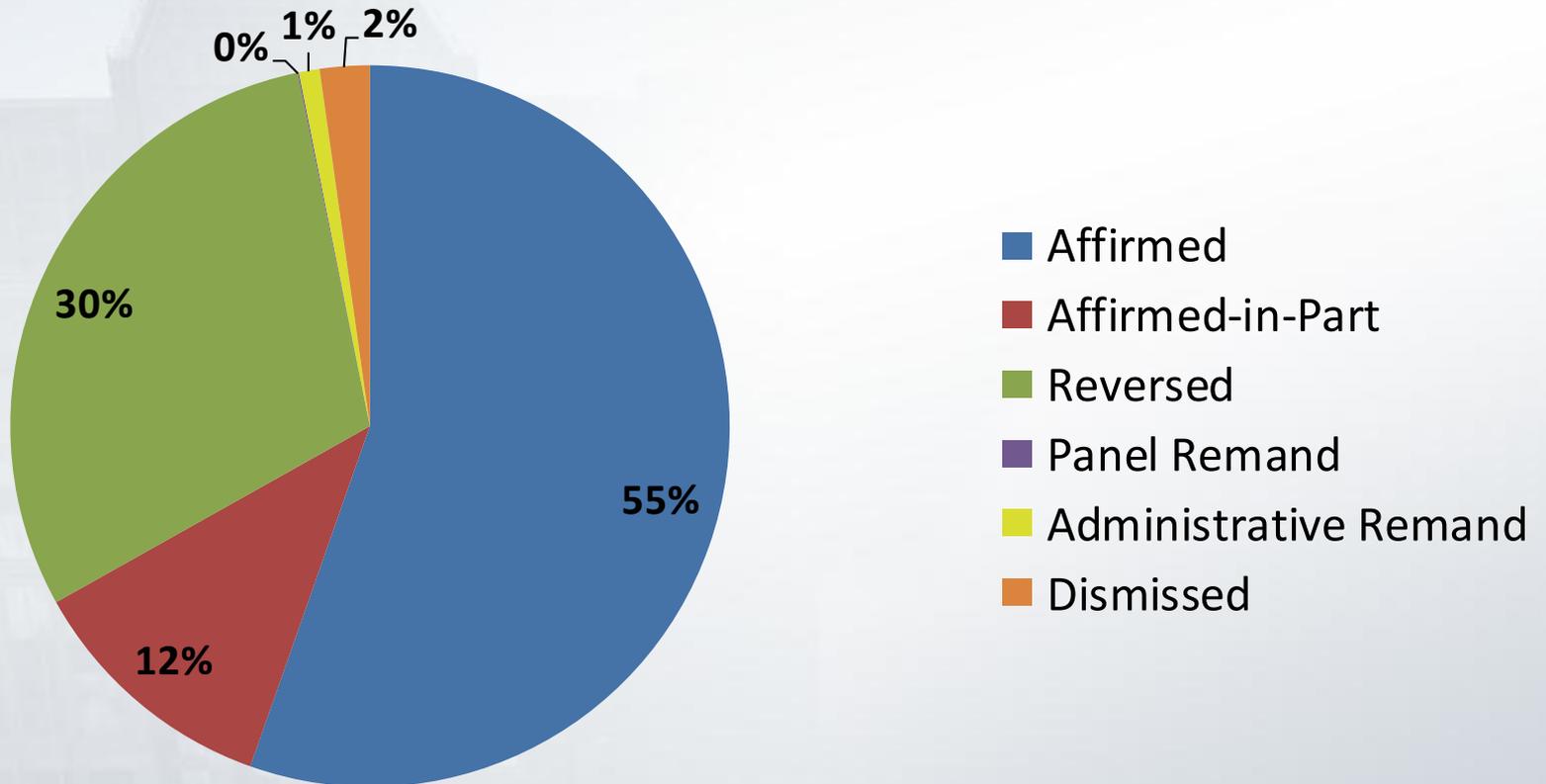
Period: 07/05/2014 thru 08/05/2014

<i>Discipline</i>	<i># Cases Received</i>	<i># Cases Disposed</i>	<i>Difference (Disposed minus Received)</i>
Biotech	50	20	-30
Business Methods	70	56	-14
Chemical	105	55	-50
Contested Cases	52	19	-33
Design	1	1	0
Electrical	240	515	275
Mechanical	217	125	-92
***Totals***	735	791	56



# Decisions by Type: FY2013

Decisions





# Administrative Patent Judge Recruitment



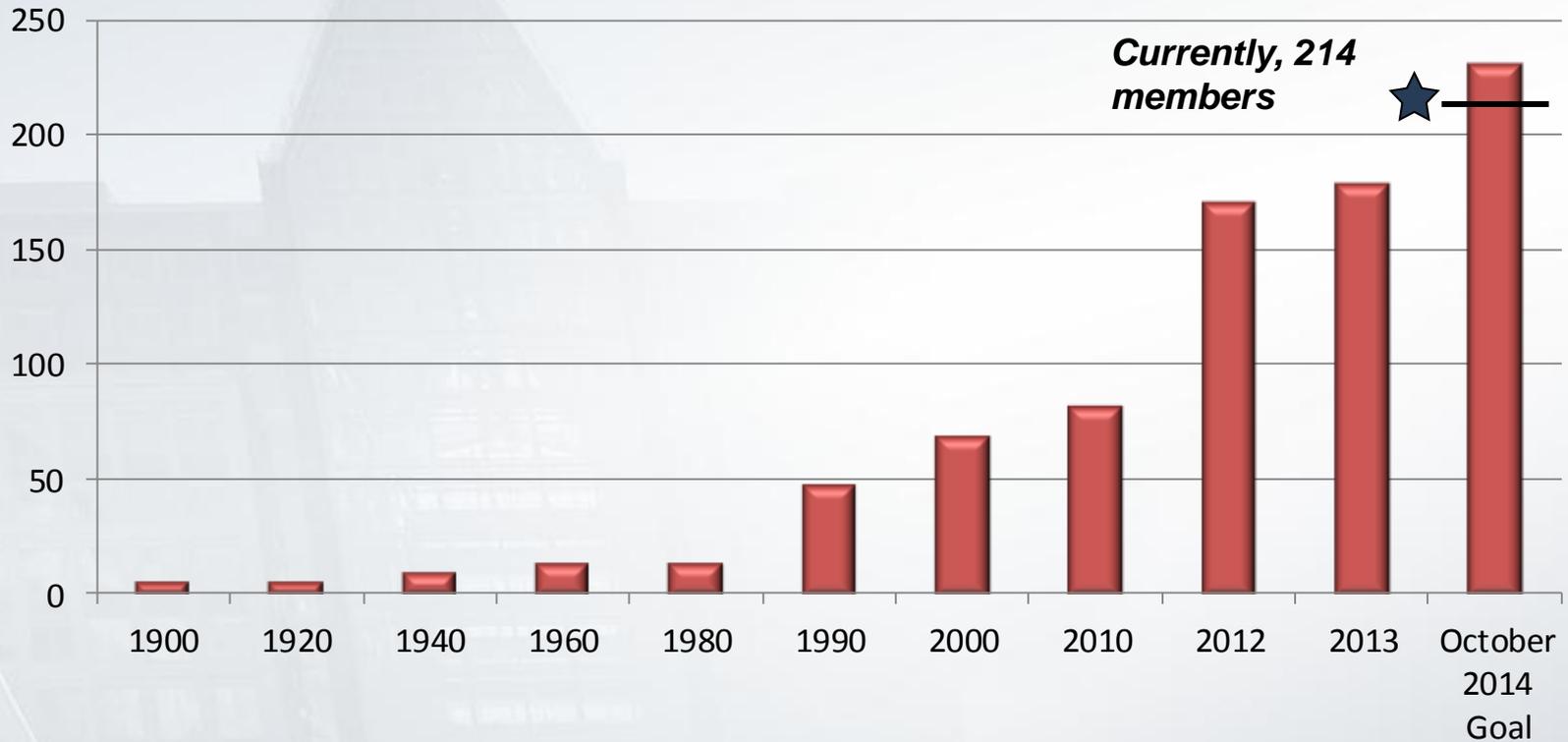
# APJ Positions

- Goal is to add 20 more judges by October 2014
- Detroit-based APJ position open on USAJOBS:
  - <https://www.usajobs.gov/GetJob/ViewDetails/377185400> (PTAB-2014-0048)
- APJ announcement open on USAJOBS for all other locations:
  - <https://www.usajobs.gov/GetJob/ViewDetails/377194800> (PTAB-2014-0049)
- Both announcements close on August 30, 2014



# Members of the Board

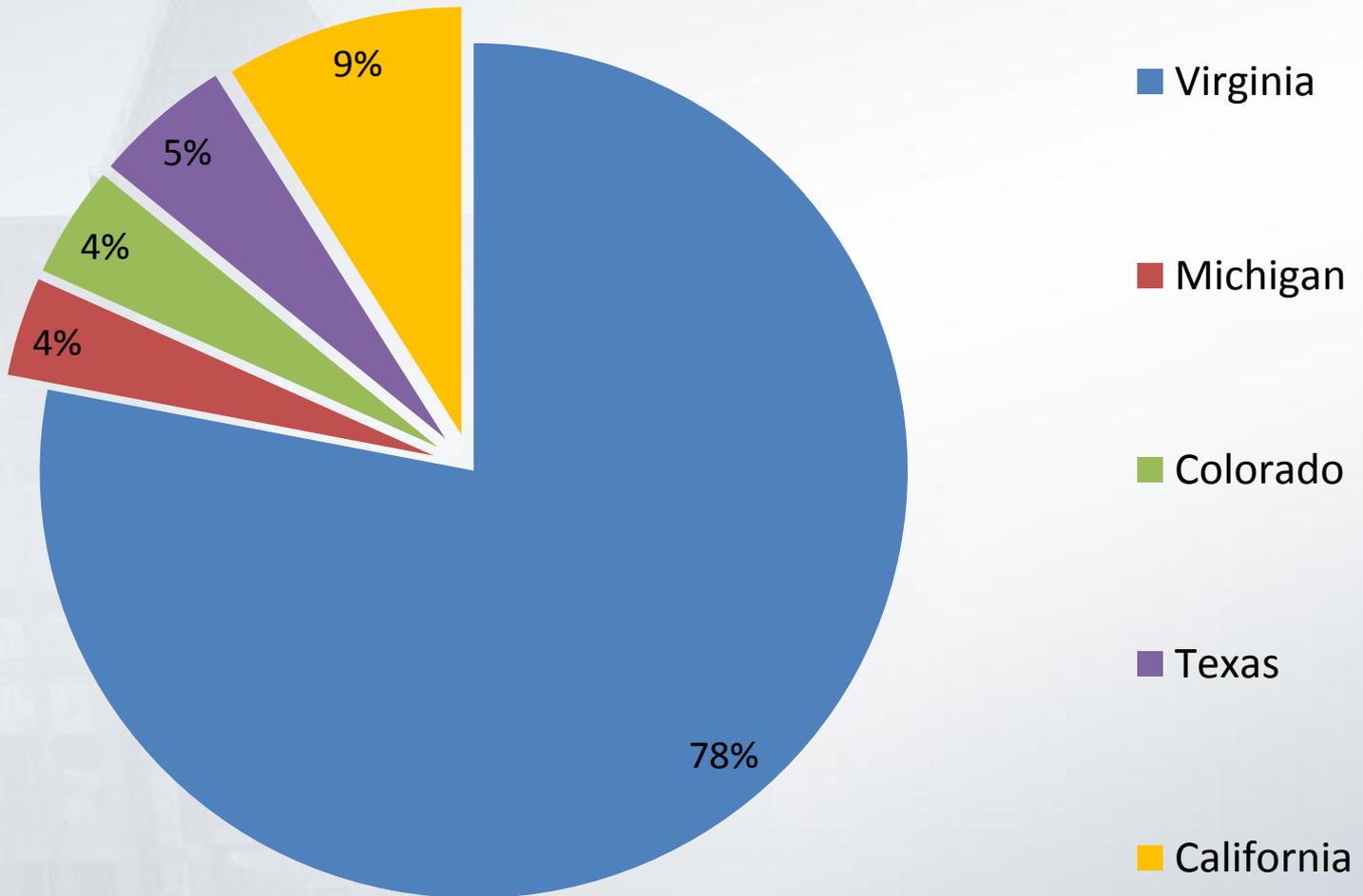
## Judges





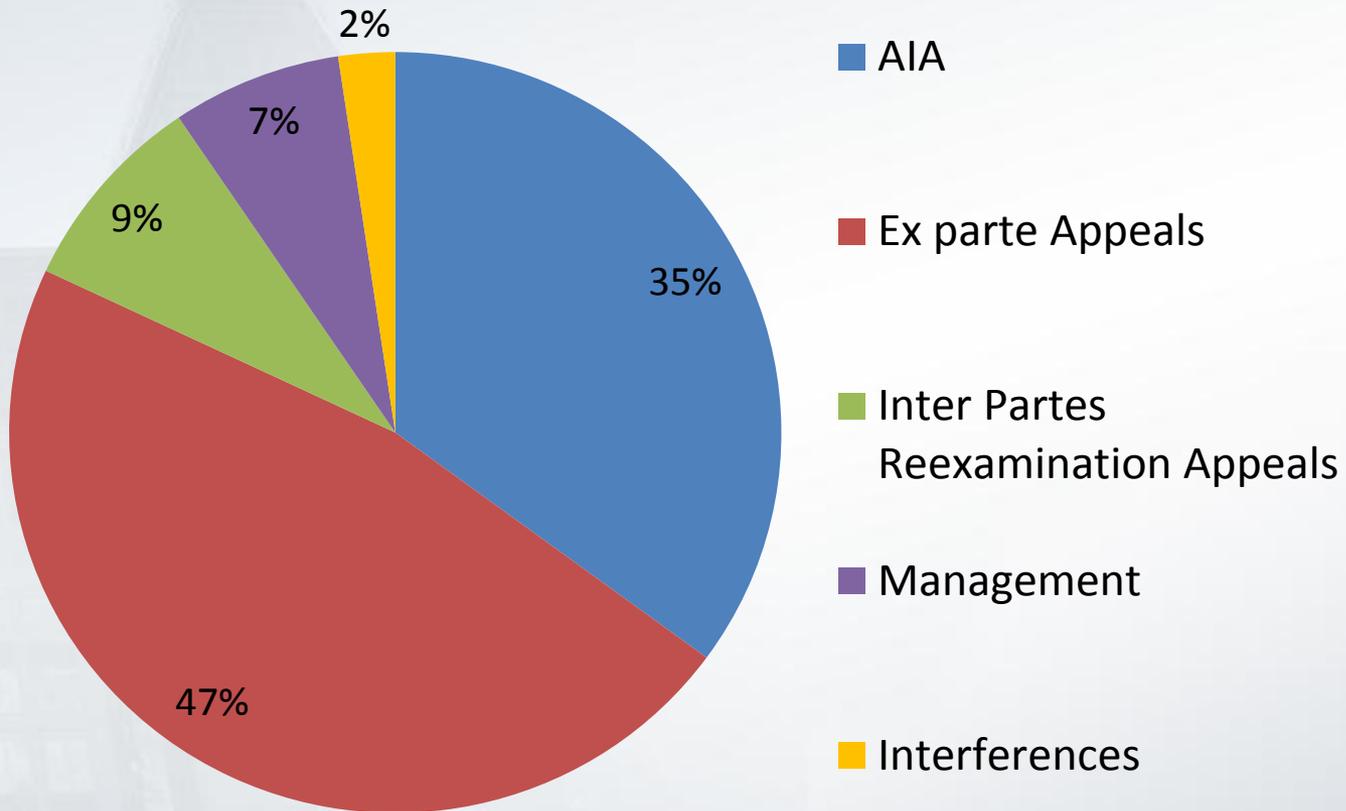
# PTAB Office Location Demographics

as of August 11, 2014





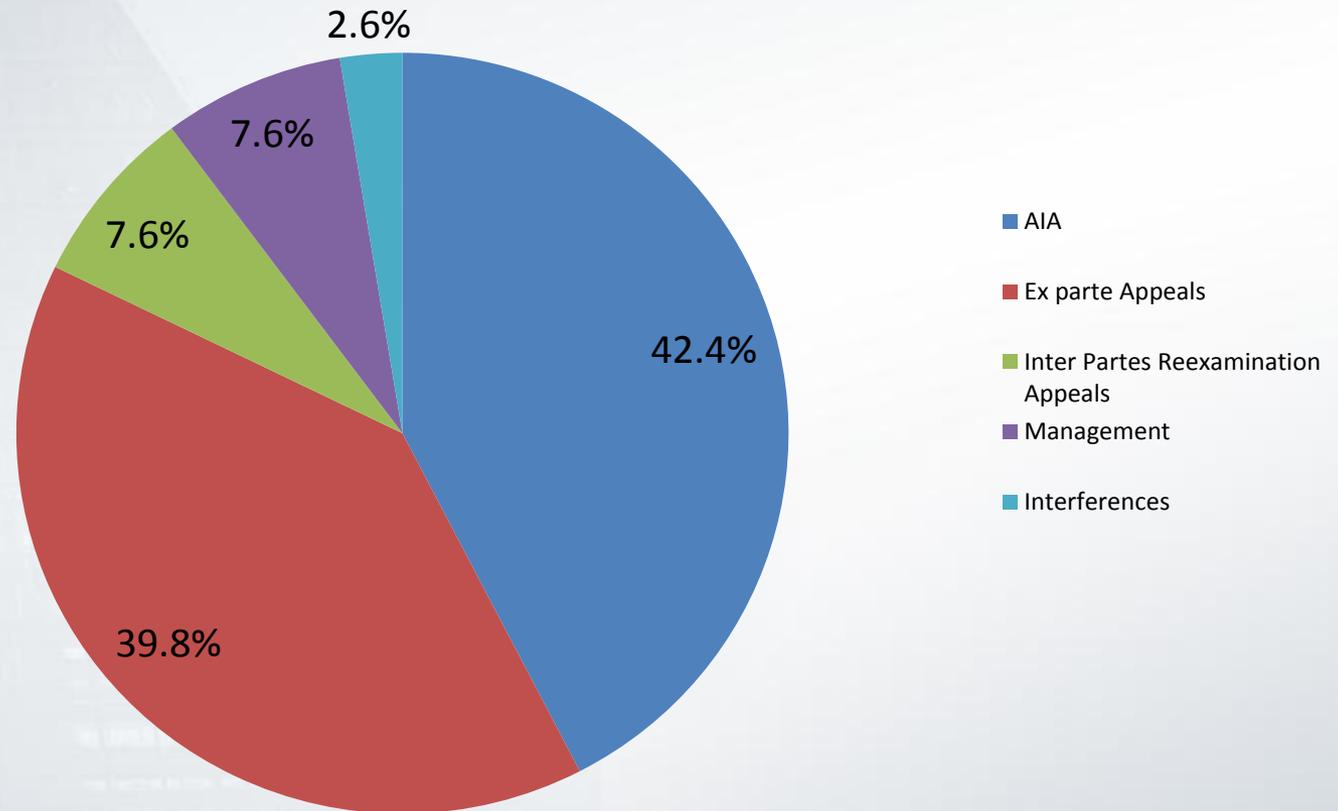
# Allocation of Judges



\* As of August 11, 2014 (214 judges)



# Expected Judge Staffing (October 1, 2014)



\* Hiring additional judges in FY 2014, for a total of 235 judges



# Administrative Patent Judge Training



# APJ Training

## **New Judge Orientation**

- All new judges participate in a one-week orientation training session.
- Topics covered include: internal Board procedures, Board organization/infrastructure, and Board resources.

## **Training Committee**

- The Board has a Training Committee that conducts formal training for all members of the Board.

## **Mentoring Program**

- The Board has a Mentoring Program that matches new judges with senior judges.



# APJ Training

## **For newer judges**

- initial guidance to ease the transition to the Board's unique mission and culture
- discussion of issues we see on a regular basis.

## **For all judges**

- discussions of case law
- training on new areas of jurisdiction

The training agenda is developing continually, based on judge input, as we constantly strive to look for new ways to more effectively and efficiently fulfill our mission.



# PTAB Website



# Revised PTAB Website

<http://www.uspto.gov/ip/boards/bpai/index.jsp>

**uspto.gov**

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an agency of the Department of Commerce

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## Patent Trial and Appeal Board

Welcome to the Patent Trial and Appeal Board. The Board's duties include review of adverse decisions, review of appeals of reexaminations, derivation proceedings, inter partes and post-grant reviews, and rendering decisions on interferences.

### TRIALS



### APPEALS



### DECISIONS



### HEARINGS



### RESOURCES



### STATISTICS



### ABOUT PTAB



### HELP



## Now Hiring

- [Administrative Patent Judges - Apply Online](#)
- [APJ Recruitment brochure \[PDF\]](#)

## Events

- [Joint 5x5 Relay and Swearing-in Ceremony, July 21, 2014 in San Jose](#)
- [Administrative Patent Judge \(APJ\) Speaking Engagements \[PDF\]](#)

## What's New

- [Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board \(FR Doc. 2014-15171\)](#)
- [PTAB Articles](#)

USPTO Message From PTAB: How to Make Successful Claim Amendments in an AIA Trial Proceeding (05MAY2014)

[>> View older PTAB messages](#)

- [A Day-in-the-Life of an APJ \[PDF\]](#)
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## System Maintenance

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# Questions and Comments?

**James D. Smith**

Chief Administrative Patent Judge

Patent Trial and Appeal Board

571-272-9797

[James.Smith@uspto.gov](mailto:James.Smith@uspto.gov)